

**DOCKET NO.:** JANS-0042 (JAB-1499 US DIV)

**PATENT**

**Application No.:** 10/817,472

**Office Action Dated:** January 17, 2006

**REMARKS/ARGUMENTS**

Claims 1 to 7, 9 to 11, 15, and 18 to 25 are pending in this application and are rejected. Applicants are herein amending claims 1, 9, 10, 15, and 18 to 22, and cancelling claim 2, without prejudice or disclaimer.

**Amendments to the Claims**

Applicants are herein amending claim 1 to delete reference to "prodrug," without prejudice or disclaimer. Applicants explicitly reserve the right to pursue the cancelled subject matter in one or more continuing applications.

Applicants are herein cancelling claim 2. In addition, applicants are herein amending claims 9 and 10 to revise the claim dependency of both so that they no longer depend from cancelled claim 2.

Applicants are herein amending claim 15 to correct a typographical error in step a) from (I') to (I).

Applicants are herein amending claims 18 to 22 to further clarify that the compound produced in any of the steps of the process of claims 18 to 22 is a compound of formula (I), as defined in claim 1, and which may be converted into another form of the formula of formula (I), as defined in claim 1. Support for the amendment may be found, *inter alia*, in original claim 1.

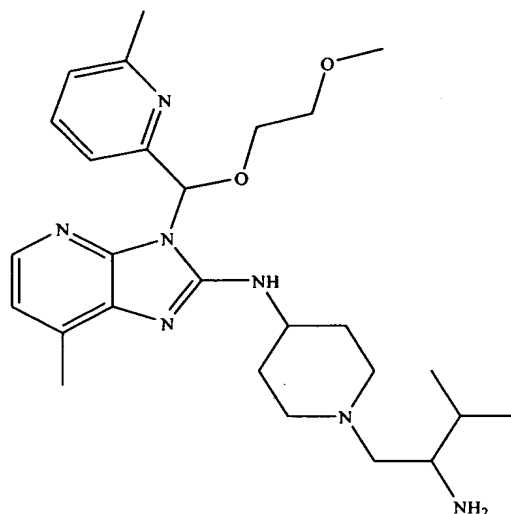
Applicants respectfully submit that the amendments to the claims do not introduce new matter; and are fully supported by the specification, as originally filed.

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**Restriction Requirement and Election of Species**

In response to the Restriction Requirement, applicants elected *with traverse*:



N-[1-(2-amino-3-methylbutyl)-4-piperidiny]-3-[(2-methoxyethoxy)(6-methyl-2-pyridinyl)methyl]-7-methyl-3H-imidazo[4,5-b]pyridin-2-amine  
(Compound 89)

In response to the election of species and request for reconsideration, the Office has indicated that it would be burdensome to search and examine compounds of formula (I) where the bivalent radical is of formula (a-3) to (a-5) and that the search and examination beyond the species indicated above was conducted and no prior art was found.

Applicants submit that a proper requirement for restriction was not established and that any restriction among the members of the Markush groups within the claims should only have been made *provisionally*. MPEP § 803.02, which addresses restriction practice with respect to Markush-type claims, clearly sets forth that the Examiner may only require a *provisional* election of a single species prior to examination on the merits. The provisional election would be given effect in the event that the Markush-type claim was found not to be allowable. Following election, the Markush-type claim would be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim were not allowable over the prior art, examination would be limited to the Markush-type claim and claims to the elected species, with claims drawn to species

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patentably distinct from the elected species held withdrawn from further consideration. *However, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim would then be extended.*

The MPEP provides an example in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E. With such a claim, the examiner may require a *provisional* election of a single species (CA, CB, CC, CD, or CE). The Markush-type claim is then examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If, on examination, the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species would be rejected, and claims to the non-elected species would be held withdrawn from further consideration. *On the other hand, if no prior art anticipates or renders obvious the elected species, the search of the Markush-type claim would then be extended.*

Thus, applicants respectfully request reconsideration of the requirement for restriction. Nonetheless, to be fully responsive to the restriction requirement and to expedite prosecution of the application, applicants have amended claim 1 to delete the non-elected subject matter.

**Rejection under 35 U.S.C. § 112, second paragraph**

Claims 1 to 7, 9 to 11, 15, and 18 to 25 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite because claim 1 species a “prodrug” of the compound of formula (I). While not addressing the merits of the rejection and solely for the purpose of expediting prosecution, applicants are herein amending claim 1 to delete the term “prodrug,” thereby rendering moot the indefinite rejection. Accordingly, applicants request withdrawal of claims 1, 3 to 7, 9 to 11, 15, and 18 to 25 under 35 U.S.C. § 112, second paragraph

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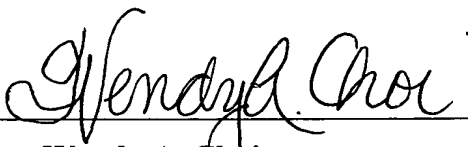
**Conclusions**

Applicants respectfully request:

- (1) entry of the amendments to the claims;
- (2) reconsideration and withdrawal of the restriction requirement; and
- (3) reconsideration and withdrawal of the rejections of the claims based on the foregoing amendments and remarks;
- (4) allowance of claims 1, 3 to 7, 9 to 11, 15, and 18 to 25.

If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (404) 459-5642.

Date: April 5, 2006

  
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